

Doc Code: AP.PRE.REQ

PTO/SB/33 (11-08)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Am100905 P1

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Signature _____

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Application Number

10/693,315

Filed

October 24, 2003

First Named Inventor

TAKAO ABE

Art Unit

1624

Examiner

mark L. Berch

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 51,289

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Michael J. Herman
Signature

Michael J. Herman
Typed or printed name

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Telephone number

1/8/09
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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Docket No.: AM100905 P1
Application No.: 10/693,315

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: Takao Abe
Application No.: 10/693,315 Group No.: 1624
Filed: October 24, 2003 Examiner: Mark L. Berch
For: PROCESS FOR PREPARING 6-ALKYLIDENE PENEM
DERIVATIVES
Confirmation No.: 1495
Customer Number: 25291

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REASON FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated July 11, 2008 and Advisory Action dated October 27, 2008, Applicants submit a Notice of Appeal and a Pre-Appeal Brief Request for Review.

The Examiner erroneously has rejected process claims 9-11, 13-30 and 32-34 as allegedly being unpatentable over compound claims 1-20 of U.S. Patent No. 7018997 (hereinafter referred to as “the ‘997 patent”) on the basis of obviousness type double patenting.

However, the process of preparing the compounds of the present invention is not obvious from the claimed compounds of the ‘997 patent. Designing processes to produce various compounds takes extensive experimental work. Nothing in the compound claims suggests the claimed method.

For a claim to be unpatentable based on obviousness-type double patenting, it must be obvious from the language of the claims in the cited patent. A claim to a compound does not make a claim to a method for making the compound obvious unless it discloses or suggests the process as a whole. If this were not true, then a compound claim would make unpatentable all claims to processes for making the compound; to the contrary, a new process for making an old compound is patentable subject matter. In the present case, the patented compound claims do not disclose or suggest the process of the pending claims.

The Examiner has cited several court decisions to support his rejection, but has misinterpreted or misapplied the case law, as is explained below.

The Examiner has cited the 1888 Supreme Court case of *Mosler Safe & Lock v. Mosler, Bahmann & Co.* However, this was a “purely mechanical case” in which the court found that the claimed method was “an old method” which involved “no exercise of the inventive faculty”. In 1894, the Supreme Court clarified that *Mosler* must be confined to its exact facts, and stated that “a single invention may include both the machine and the manufacture it creates, and in such cases, if the inventions are really separable, the inventor may be entitled to a monopoly of each.” *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197, 14 S.Ct. 310, 38 L.Ed. 121 (1894).

Unlike in *Mosler*, the process at issue here is not purely mechanical. Nor is there any argument that the process is not new or that the process is merely the use of an old method that requires no inventive faculty. Neither *Mosler* nor any other Supreme Court case broadly prohibits an inventor from receiving a process patent after earlier obtaining a product patent where the inventor could have presented the claims in a single patent. *Takeda Pharmaceutical Co., Ltd. v. Dudas*, 511 F.Supp.2d 81, 84 U.S.P.Q.2d 1365, (D.D.C. Sep 18, 2007).

The Examiner has cited *In re Freeman*, in which product claims were found to be obvious based on process claims. However, in that case the product was defined by the process, i.e., they were product by process claims; this is not the case here.

The Examiner also states that it does not matter whether the compound claim or the process claim is patented first. Applicants strongly disagree. A process for making compound X must disclose compound X, but a claim to compound X need not disclose a process. In the present case, the cited patent claims do not teach or suggest the presently claimed process.

The Examiner’s citation of *Ex parte MacAdams* is also not on point. The claims that were rejected were claims for a method of using a product in the manner in which the product was designed to be used. The case contains *dicta* that, “method claims drawn to the generally conventional method of making a composition are obvious.” However, there is no generally conventional process for making the compound of the present

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invention. Applicants method was the result of extensive research, and is not obvious merely from knowledge of the compound to be made.

The Examiner has cited additional cases (*Geneva Pharmaceuticals*, and *In re Boylan*) which are also relating to methods of using rather than methods of making, and has stated that he cannot see any reason why these two situations should be treated differently. However, they are different. The Examiner has erroneously used a rote analysis, rather than applying the proper standard for obviousness.

In a proper obviousness analysis, the Examiner should consider the differences between the patent claims and the pending claims and determine whether the differences are obvious from the patent claims. In this case, the process steps of the pending claims represent a significant difference from the patent claims; the Examiner has not provided any reasons to support his assertion that these process steps are obvious from the patent claims. Applicants claim a specific multi-step process. In view of the known unpredictability of the chemical arts, it is certainly not obvious from the mere knowledge of the end product.

Furthermore, it is highly likely that the compound could be made by other processes. Nothing in the compound claims would lead one of ordinary skill to the particular process claimed by Applicants.


The Examiner has expressed concern that the process claims will extend Applicants monopoly beyond the term of the compound claims. However, since the priority date is the same in both cases, all of the claims should have the same expiration date.

For all of these reasons, Applicants believe that the Examiner's rejection should be withdrawn.

The Commissioner is hereby authorized to charge any fees required and any additional fees that may be needed to Deposit Account No. 01-1425, in the name of Wyeth.

Respectfully submitted,

Date: 1/08/09



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